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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,364	06/04/2001	Naomi Go	09793822-014	3070
7590	12/05/2003		EXAMINER	
David R Metzger Sonnenschein Nath & Rosenthal P O Box #061080 Wacker Drive Station Chicago, IL 60606-1080			TO, BAOQUOC N	
			ART UNIT	PAPER NUMBER
			2172	
			DATE MAILED: 12/05/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

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## ***Office Action Summary***

-- **The MAILING DATE of this communication appears**

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of NO (0) days is required.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED.
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, will result in a loss of patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1,4-6,8-10,12-14 and 16-22 is/are pending in the application.  
4a) Of the above claim(s) 2,3,7,11 and 15 is/are ~~withdrawn from consideration~~ canceled.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1,4-6,8-10,12-14 and 16-22 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 2-3, 7, 11 and 15 are canceled and claims 1, 12-13 and 20-22 are amendment.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 12-13 and 21-22 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 4-6, 8-10, 12-14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over NOTO NOBUHARU (11-143885) in view of Minami et al. (US. Patent No. 6,212,521).

Regarding on claim 1, NOBUHARU teaches an information processing apparatus for providing position information indicative of a position of information, comprising:

A database storing discrimination information (Barcode) assigned to an object constituting information and said position information (URL) corresponded (page 4 of 6, lines 28-33);

Collections means for collecting said discrimination information of the object (Barcode) constituting of the information from said information which is represent on a

network, and the position information of the information (URL), and registering the collected discrimination information and position information corresponded in said database (page 2-6, lines 2-28 and page 3 of 6, lines 15-20);

Receiving (server received barcode for URL) means for receiving discrimination information assigned to an object constituting information transmitted from a terminal (page 2 of 6, lines 26-38 and pages 3 of 6, lines 15-20);

Search (search) means for searching said position information (URL) corresponded to discrimination information from said terminal from a database storing discrimination information assigned to the object constituting information and said position information with respect to the information corresponded (page 2 of 6, lines 4-25, and page 3-6, lines 15-20);

Preparing means for preparing a list of said position information searched (the system prepare the list of URL) (page 4 of 6, lines 14-20); and

Transmission means for transmitting said list of position information (returns the URL list to the user) (page 4 of 6, lines 14-20).

NOBUHARU does not explicitly teach issue means for issuing said discrimination information not registered in said database in response to the request from said terminal. However, Minami teaches, "that a user has issued a data retrieval request for some non-registered data. This teaches in fact the worst situation, where all data management servers in the system are forced to conduct data searches which would end up with totally fruitless results" (col. 3, lines 25-30). This teaches the system allows the user to retrieve the non-register data. Therefore, it would have been obvious to one

ordinary skill in the art at the time of the invention was made to modify retrieval of non-register data in Minami into NOBUHARU in order to provide the system of non-registered data although it is the fruitless results.

Regarding on claims 4, NOBUHARU teaches the collects means collects related to said object, and registers said position information and related information corresponding to said discrimination information in said database (Page 2 of 6, lines 2-28).

Regarding on claim 5, NOBUHARU teaches related information includes a keyword used to search discrimination information assigned to said object (page 2 of 6, lines 2-38);

Said receiving means receives said key word transmitted from said terminal (page 2 of 6, lines 2-38);

Said search means searches said discrimination information corresponded to the related information including said key word received by said receiving means (page 2 of 6, lines 2-38); and

Said transmission means transmits the search result of said discrimination information to said terminal (page 2 of 6, lines 2-38).

Regarding on claim 6, NOBUHARU teaches addition means for adding the importance degree to said object, wherein said preparing means prepares a list of said position information searched on the basic of said importance degree (Page 2 of 6, lines 2-38).

Regarding on claim 8, NOBUHARU teaches information is a file described in a predetermined description language (Page 2 of 6, lines 4-38).

Regarding on claim 9, NOBUHARU teaches predetermined description language is HTML (Hyper Text Markup Language) (Page 5 of 6, lines 30-35).

Regarding on claim 10, NOBUHARU teaches position information is URL (Uniform Resource Locator) (Page 2 of 6, lines 45-49).

Regarding on claims 12 and 13, NOBUHARU teaches a recording medium in which a program for causing a computer to execute information processing for providing position information indicative of a position of information, a program being recoded, said program comprising:

Searching (searching) step for searching position information (information-resource identifier) transmitted from a terminal corresponded to discrimination information from said terminal from a database storing discrimination information assigned to the object constituting information and said position information with respect to the information corresponded (page 2 of 6, lines 4-25 and page 3 of 6, lines 15-20);

Preparing step for preparing a list of said position information searched (preparing barcode symbol) (page 4-6, lines 14-20); and

NOBUHARU does not explicitly teach issue means for issuing said discrimination information not registered in said database in response to the request from said terminal. However, Minami teaches, "that a user has issued a data retrieval request for some non-registered data. This teaches in fact the worst situation, where all data management servers in the system are forced to conduct data searches which would

end up with totally fruitless results" (col. 3, lines 25-30). This teaches the system allows the user to retrieve the non-register data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify retrieval of non-register data in Minami into NOBUHARU in order to provide the system non-registered data although it is the fruitless results.

Regarding on claim 14, NOBUHARU teaches input for inputting said discrimination information transmitted to said transmission means (Page 3 of 6, lines 4-17).

Regarding on claim 16, NOBUHARU teaches request means for requesting said server to search said discrimination information by a keyword (Page 2 of 6, lines 4-17).

Regarding on claim 17, NOBUHARU teaches information is a file described in a predetermined description language (Page 5 of 6, lines 4-17).

Regarding on claim 18, NOBUHARU teaches predetermined description language is HTML (Hyper Text Markup Language) (Page 2 of 6, lines 45-49).

Regarding on claim 19, NOBUHARU teaches position information is URL (Uniform Resource Locator) (Page 2 of 6, lines 45-49).

Regarding on claims 20-21, NOBUHARU teaches an information processing method for requesting a server for providing position information indicative of a position of information said position information, comprising:

Transmission (send the information to computer network) step for transmitting discrimination information assigned to an object constituting information to said server (Page 2 of 6, lines 26-31);

Receiving step for receiving a list of said position information (list of object identifiers) with respect to said information constituted from said object to which the discrimination information transmitted from said server corresponding to the transmission of said discrimination information is assigned (Page 3 of 6, lines 17-21);

Display control (output) step for displaying the list of said position information (page 5 of 6, lines 22-26); and

NOBUHARU does not explicitly teach issue means for issuing said discrimination information not registered in said database in response to the request from said terminal. However, Minami teaches, "that a user has issued a data retrieval request for some non-registered data. This teaches in fact the worst situation, where all data management servers in the system are forced to conduct data searches which could which would end up with totally fruitless results" (col. 3, lines 25-30). This teaches the system allows the user to retrieve the non-register data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify retrieval of non-register data in Minami into NOBUHARU in order to provide the system non-registered data although it is the fruitless results.

Claim 22 is rejected same reason as claims 21 and 22, in addition NOBUHARU also teaches terminal comprising second transmission for transmitting discrimination information assigned to an object constituting information to said server (page 2 of 6, lines 36-38 and page 3-6, lines 15-10); second receiving means for receiving a list of said position with respect to said information constituted from said object to which the

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discrimination information transmitted from said server corresponding to the transmission of said discrimination information is assigned (page 2 of 6, lines 4-25).

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is (703) 305-1949 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached at (703) 305-4393.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

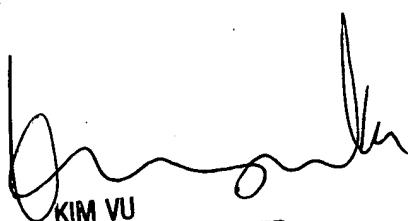
Commissioner of Patents and Trademarks  
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The fax numbers for the organization where this application or proceeding is assigned are as follow:

- (703) 746-7238 [After Final Communication}]
- (703) 746-7239 [Official Communication]
- (703) 746-7240 [Non-Official Communication]

Hand-delivered responses should be brought to:

Crystal Park II  
2121 Crystal Drive  
Arlington, VA 22202  
Fourth Floor (Receptionist).



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